



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,625	01/31/2004	Leone Dall'asta	SAIC 20.931 (100788-00071)	1735
26304	7590	04/22/2005	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,625

Applicant(s)

DALL'ASTA ET AL.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-14, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1626

Claims 1-26 are pending in this application.

Claims 15-23, 26 are drawn to non-elected invention.

Restriction Requirement

The election of group I, claims 1-14, 24-25, in the Paper filed 3/24/05 is hereby acknowledged. There is no indication whether the election is made with or without traverse. Therefore, it is deemed made without traverse.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-14, 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification lacks adequate support for the claims. The specification fails to provide support that any or all known "optically active acids" (claim 25) are applicable in the instant process. The term R' in claim 1, line 5, is not defined in the specification so as to determine the structures of compounds that are included and/or excluded by the term. The term is defined with the phraseology "such as" on line 15, page 5 of the specification. Therefore, the listed compounds are deemed examples only. However, "[e]xemplification is not an explicit definition." Claim Interpretation, 2004. The specification must set forth any definition explicitly

Art Unit: 1626

with reasonable clarity, precision and deliberateness, *Teflex Inc. v. Ficos North Ame. Corp.*, 63 USPQ2d 1374 1381 (Fed Cir, 2001). Applicant must show possession of the invention by describing it with all the claimed limitations. *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997). By amending the claims to recite the specific optically active acids and compounds represented by R' having support in the specification the rejection would be overcome.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-14, 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4-14, 24-25 are rejected as being indefinite for reasons set forth above under 35 U.S.C. 112, first paragraph. It is not possible to ascertain the metes and bounds of the claims. Claim 1 is an omnibus claim. It is not clear what applicant is claiming because there is no relationship between each of steps (c) to (f) and between step (b) and the rest of the claim. Therefore, claims 1-14, 24-25 are indefinite. The phraseology "straightforwardly converted" in claims 1 and 8 renders claims 1-14 and 24-25 confusing and therefore indefinite. Claims 2, 24-25 as written are confusing and therefore, indefinite. A claim must stand alone to define the invention, and incorporation into the claims by reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993).

Claims 1, 8, 14, 24-25 are written in functional language and therefore broader than the enabling disclosure in the specification. Therefore, claims 1-14, 24-25 are indefinite. For example, the claims recite, "converting", "cyclizing", "removing", "isolated", etc. Applicant cannot

Art Unit: 1626

claim all processes of "converting", cyclizing", "removing" or isolating, that may be applicable in the instant process. Applicant must claim only the process of "converting", cyclizing", "removing" or isolating that embody applicant's invention having support in the specification. The claims must recite the reaction conditions such as reagents, buffer, solvents, pH, etc. that are applicable in the reactions. Under US patent practice a process claim must recite how the process is performed not what is done as in the instant claims. In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guazzi et al., WO 02/48133.

Applicant claims a process of making citalopram from 5-formylphthalide as set forth in steps (a) to (f) in claim 1. In an optional embodiment the H of OH in hydroxylamine (a reagent) can be replaced with any substituent, which is inert under Grignard reaction condition. See the specification at page 5, lines 14-15. The fact that the substituted hydroxylamine compounds are applicable in the process implies they are analogous compounds of hydroxylamine.

Determination of the scope and content of the prior art (MPEP §2141.01)

Art Unit: 1626

Guazzi et al., teach a similar process of making citalopram (formula I) from 5-formylphthalide (formula VIII). See the reaction scheme at page 4.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant invention and that of Guazzi et al., is that the first step in applicant's process is the 2nd last step in the process of Guazzi et al. Also, Applicant does not perform the first step of Guazzi et al., i.e. the conversion of 5-formylphthalide to the corresponding acetal (formula VII).

Finding of prima facie obviousness--rational and motivation (MPEP §2142.2413)

All the reagents in the instant steps are the same as that of Guazzi et al. Therefore, the instant process is no more than a selective combination of the process of Guazzi et al., done in a manner obvious to one of ordinary skill in the art. *In re Mostovych*, 144 USPQ 38 (CCPA 1964). Also, the use of analogous starting material in a well-known process is prima facie obvious. *In re Durden*, 226 USPQ 359, (1985).

Priority Document

Applicant claims priority to a PCT and a foreign document. However, the English Language translations of the documents are no yet received.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Taofiq A. Solola whose telephone number is (703) 308-4690.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

Art Unit: 1626

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Taofiq Solola', written in a cursive style.

TAOFIQ SOLOLA
PRIMARY EXAMINER
Group 1626

April 20, 2005